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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,696	01/05/2004	David S. Smith	220907102003B	1695

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EXAMINER
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FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,696

Applicant(s)

SMITH, DAVID S.

Examiner

David T. Fidei

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The replacement drawings were received on January 06, 2006. These drawings are accepted by Examiner.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1, 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the diameter" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the circumference" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 appears redundant in that inserts are previously recited in claim 1 that alter the diameter of said at least two trays.

As this action is being made final, changing "the" to -a- in line 5 of claim 1, before "diameter", changing "the" to -a- circumference and canceling claim 6 would overcome this rejection for purposes of appeal.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3728

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 4-7 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Lisch (Patent no. 5,542,206). A generally circular case 10 is disclosed comprising at least two storage trays 12 with and inserts 42 within at least two of the storage trays that alter the diameter of the at least two storage trays, e.g., see figure 5.

As to claim 4, a drawer pull mechanism is defined by finger hole 36 in communication with said at least two storage trays, see col. 3, lines 14-16.

As to claim 5 a latching mechanism 20 is in communication with said at least two storage trays.

As to claim 6, the inserts 42 alter the interior diameter of at least two storage trays.

As to claim 7, a handle 62 is in communication with at least two storage trays.

6. Claims 1-6 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Essman (Patent no. 2,582,421). A generally circular case is disclosed in figures 2 and 5 comprising at least two storage trays 10 with and inserts 16 within said at least two storage trays that alter the diameter of said at least two storage trays, e.g., see figures 4 and 6.

As to claim 2, a pivot pin 18 in communication with said at least two storage trays and is positioned along the circumference of each of the at least two tray as shown in figure 6 and recited in claim 3.

As to claim 4, a drawer pull mechanism is defined by hand grip 15 in communication with said at least two storage trays 10, see col. 2, lines 31-32.

As to claim 5 a latching mechanism 20 is in communication with said at least two storage trays.

As to claim 6, the inserts 16 alter the interior diameter of at least two storage trays.

Art Unit: 3728

7. Claims 1-6 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Pfrommer (Patent no. 3,392,868). A generally circular case is disclosed comprising at least two storage trays 14, 15 or 16 with and inserts 18 within each storage tray that alter the diameter of said at least two storage trays, e.g., see col. 2, lines 34-37.

As to claim 2, a pivot pin 25 in communication with said at least two storage trays and is positioned along the circumference of each of the at least two tray as shown in figures 2 & 3, and recited in claim 3.

As to claim 4, a drawer pull mechanism is defined by finger nail grooves 36 in communication with said at least two storage trays, see col. 3, lines 36.

As to claim 5 a latching mechanism 34/35 is in communication with said at least two storage trays.

As to claim 6, the inserts 18 alter the interior diameter of at least two storage trays.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection. A generally circular case is well known in the art as evidenced by the substantial prior art further cited.

9. While it is acknowledged the case is recited "for" carrying and storing circular saw blades, it is noted that in order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE. The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited.

It is also noted, a reference that contains all the structure defined in a claim, but not the recited use anticipates the claim because a new use does not make an old product patentable, In

Art Unit: 3728

re Schreiber, 128 F.3d 1473, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997). Accordingly, in view of the new language added to the claims, it is submitted the present invention fails to define anything novel over the prior art.

As to the rejections under 35 U.S.C. 112, second paragraph, the Examiner does not concur antecedent basis is provided for the terms "diameter" or "circumference". Even though the case is defined to be generally circular, nothing within the claims define a diameter or circumference of either the case or trays. While applicant may argue they both are generally circular, these terms simply lack antecedent basis. Rather belabor the point, a simple avenue for meeting the requirements of 35 U.S.C. 112, second paragraph has been provided for possible appeal purposes. Particularly since rejections of this type (35 U.S.C. 112, second paragraph) could be construed as merely a question of form rather than substance.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are

Art Unit: 3728

unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
August 8, 2005